



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Offic

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/529,543	04/14/00	SCHWARZ	E MERCK-2084

023599 HM12/0808
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EXAMINER
TRAN, S

ART UNIT	PAPER NUMBER
1615	10

DATE MAILED: 08/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action	Application No. 09/529,543	Applicant(s) Schwarz et al.
	Examiner Susan Tran	Art Unit 1615
		
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<p>THE REPLY FILED <u>Jul 23, 2001</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.</p>		
THE PERIOD FOR REPLY [check only a) or b)]		
<p>a) <input checked="" type="checkbox"/> The period for reply expires <u>3</u> months from the mailing date of the final rejection.</p>		
<p>b) <input type="checkbox"/> In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.</p>		
<p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>		
<p>1. <input type="checkbox"/> A Notice of Appeal was filed on _____: Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.</p>		
<p>2. <input type="checkbox"/> The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.</p>		
<p>3. <input type="checkbox"/> The proposed amendment(s) will not be entered because:</p> <ul style="list-style-type: none"> (a) <input type="checkbox"/> they raise new issues that would require further consideration and/or search. (See NOTE below); (b) <input type="checkbox"/> they raise the issue of new matter. (See NOTE below); (c) <input type="checkbox"/> they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or (d) <input type="checkbox"/> they present additional claims without cancelling a corresponding number of finally rejected claims. 		
<p>NOTE: _____</p>		
<p>4. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____ _____</p>		
<p>5. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).</p>		
<p>6. <input checked="" type="checkbox"/> The a) <input type="checkbox"/> affidavit, b) <input type="checkbox"/> exhibit, or c) <input checked="" type="checkbox"/> request for reconsideration has been considered but does NOT place the application in condition for allowance because: <i>see attachment</i> _____</p>		
<p>7. <input type="checkbox"/> The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.</p>		
<p>8. <input checked="" type="checkbox"/> For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any): Claim(s) allowed: _____ Claim(s) objected to: _____ Claim(s) rejected: <u>1-20</u> _____</p>		
<p>9. <input type="checkbox"/> The proposed drawing correction filed on _____ a) <input type="checkbox"/> has b) <input type="checkbox"/> has not been approved by the Examiner.</p>		
<p>10. <input type="checkbox"/> Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</p>		
<p>11. <input type="checkbox"/> Other: _____</p>		

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ATTACHMENT

Receipt is acknowledged of applicants' Preliminary Amendment A filed 04/14/00, Information Disclosure Statement filed 08/10/00, Change of Address filed 01/31/01, Requested for Extension of Time filed 02/13/01, Amendment B filed 02/13/01, and Request for Reconsideration filed 07/23/01.

Response to Arguments

1. Applicant's arguments filed 07/23/01 have been fully considered but they are not persuasive.

For the 102(b) rejections, the rejected claims per se are product claims. Product-by-process claims are not limited to the manipulations of the recited steps, and therefore, the patentability is based on the product itself.

Argument of a composition of 95% xylitol and 5% lactitol disclosed in applicant's specification would not establish the range of xylitol content of more than 95% and any polyol of less than 10%. There is no claim presented that is the scope of the examples referenced by applicant in the remarks.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600